

1092.0007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicant: WERATEDOGS, LLC

Application No.: 88/692,341

Law Office 101

Filed: November 14, 2019

Attorney: IM, JEAH H.

Mark: TELL YOUR DOG I SAID HI

RESPONSE UNDER 37 C.F.R. §2.62

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Applicant respectfully requests reconsideration of and otherwise traverses the February 19, 2020, Office Action issued pursuant to the above-captioned application.

I. **FAILURE TO FUNCTION REFUSAL**

The outstanding Office Action indicates that the “applied-for mark as used on the specimens of record does not function as a trademark to indicate the source of applicant’s goods and to identify and distinguish them from others,” and that the “applied-for mark appears to be incapable of functioning as a source-identifier for applicant’s goods.” Specifically, the outstanding Office Action states that the “applied-for mark does not function as a trademark because it is merely a decorative or ornamental feature of the goods” and that the “applied-for mark is a commonplace term, message, or expression widely used by a variety of sources that merely conveys and ordinary, familiar, well-recognized concept or sentiment.”

A. ORNAMENTAL OR DECORATIVE

“To be a mark, the phrase must be used in a manner calculated to project to purchasers or potential purchasers a single source or origin for the goods.” Disorderly Kids, LLC, No. CANCELLATION 92062027, 2018 WL 6120080, at *6 (Nov. 20, 2018), citing to *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455, 1459 (TTAB 1998). “Matter that serves primarily as a source indicator, either inherently or as a result of acquired distinctiveness, and that is only incidentally ornamental or decorative, can be registered as a trademark.” *Id.* citing to *In re Paramount Pictures Corp.*, 213 USPQ 111, 1115 (TTAB 1982) (“In every case, the question is not whether the mark has been associated with the goods by a particular mode or manner, but whether the matter sought to be registered performs the function of a trademark by signifying to purchasers the source of the goods sold or offered for sale.”). Thus, “[t]he critical inquiry in determining whether a designation functions as a mark is how the designation would be perceived by the relevant public. To make this determination we look to the specimens and other evidence of record showing how the designation is actually used in the marketplace.” *Id.* at 6 citing to [In re Eagle Crest Inc.](#), 96 USPQ2d 1227, 1229 (TTAB 2010) (citations omitted).

In *Disorderly Kids, LLC*, a non-precedential decision providing guidance on this issue, the Trademark Trial and Appeal Board (TTAB) dismissed a petition to cancel, for failure to function as a mark, *inter alia*, the mark SMILE MORE in standard characters, identifying the following goods and services:

Pens, rubber bands, stickers, in International Class 16;

Backpacks, in International Class 18;

Beanies, shirts, tank tops, in International Class 25; and

On-line retail store services featuring apparel and clothing, in International Class 35.

In doing so, the Board acknowledged a clear association between the mark and the Respondent in part based on the Respondent's services displaying the mark SMILE MORE in a non-ornamental manner in association with "The Official Smile More Store" and "Roman Atwood Pranks" YouTube channel. *Disorderly Kids* at pp. 4, 6, 7. The Board further went on to state "Thus, the designation SMILE MORE as it appears on Respondent's goods conveys to the public a secondary source, namely, Respondent Roman Atwood, his YouTube Channel and the content he posts there, and is registerable on the Principal Register." *Id.* at 7 citing to *In re Paramount Pictures Corp.* ("in this case, wording on a T-shirt 'inherently tells the purchasing public the source of the T-shirt, not the source of the manufacturer but the secondary source.'")

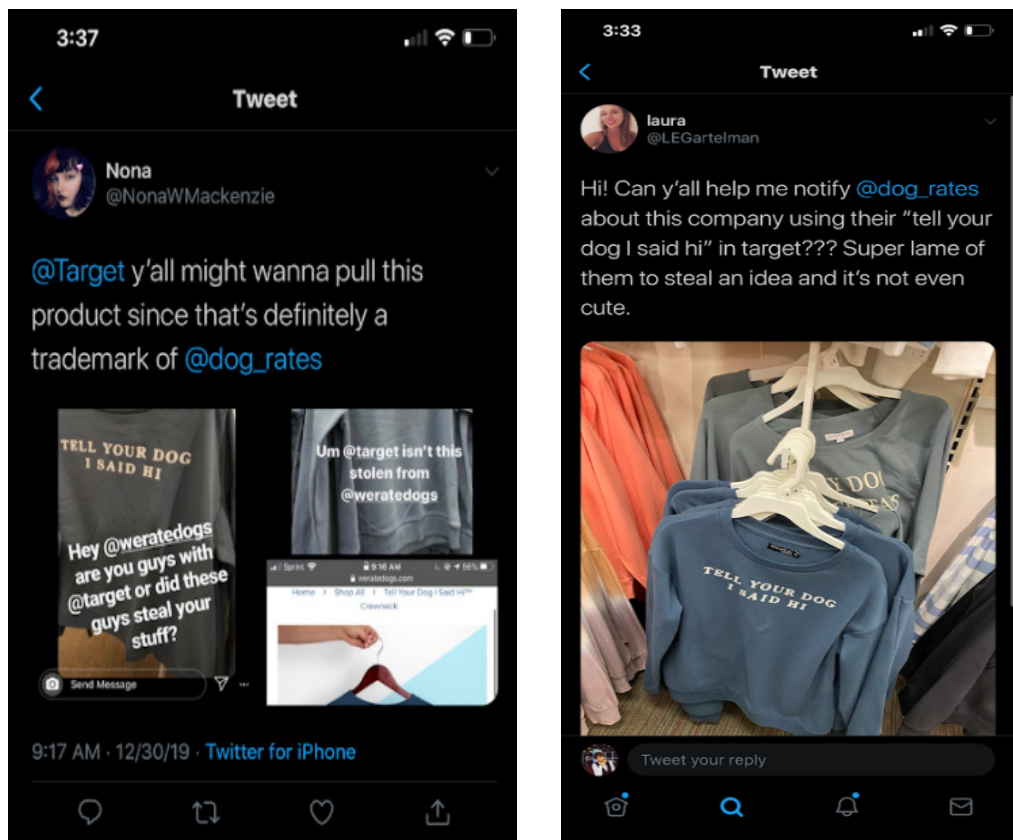
The dismissal was issued despite evidence submitted by the Petitioner in the form of "Smile More" t-shirts, hats and stickers available for sale from third-party vendors on amazon.com and other online retailers.

Applicant respectfully submits that for similar reasons the mark TELL YOUR DOG I SAID HI is not merely a decorative or ornamental feature of the goods but instead conveys to the public the source of the goods, namely the Applicant WeRateDogs, LLC, their online social media and storefront and content posted there. That the mark TELL YOUR DOG I SAID HI serves primarily as a source indicator is evident for a variety of reasons.

First, as illustrated in Exhibit 1, the mark is clearly associated with the Applicant via a search for the mark on the Internet. When searching for the mark, both Google and Bing provide as the first search result a link entitled “Tell Your Dog I Said Hi – WeRateDogs”. In fact the URL itself associated with the link includes both the mark and the source (Applicant) - <https://weratedogs.com/collections/tell-your-dog-i-said-hi>. Further, when activated, the link resolves to the WeRateDogs, LLC online store which has a non-ornamental collection entitled with the mark. Additionally, like with *Disorderly Kids*, the specimens submitted with the present application provide a clear association based on a display of the mark in a non-ornamental manner in association with Applicant’s online store.

Second, Applicant’s Twitter account (https://twitter.com/dog_rates?ref_src=twsrc%5Egoogle%7Ctwcamp%5Eserp%7Ctwgr%5Eauthor) WeRateDogs (@dog_rates), which has over 8.8 million followers (almost identical to Atwood’s Youtube following of 9.1 million highlighted by the Board in *Disorderly Kids*), and Instagram account, which has over 1.7 million followers, are replete with the use of the mark in connection with the goods thereby firmly establishing the promotion and branding of the mark as associated with the Applicant. As such, followers of Applicant’s online social media presence have come to associate the mark with the Applicant. One example of the clear association between the mark and the Applicant comes from Applicant’s aforementioned online store which has sold over 30,000 products having the mark. Another example of such an association, comes from the numerous tweets to Applicant’s Twitter account and direct emails notifying them of

the mark being used in a different marketplace. Exhibits 2 and 3 illustrate a small subset of such notifications.



Thus, like in *Disorderly Kids*, many followers and fans have sent the Applicant pictures of t-shirts from third parties bearing the mark along with corresponding complaints highlighting their belief that the Applicant is the source of the mark and associated goods carrying the mark. This illustrates how the applied-for-mark clearly performs the function of a trademark by highlighting public perception of the mark as well as how it signifies to purchasers the source of the goods sold or offered for sale. *Disorderly Kids* at pp. 6 and 7. Further, like in *Disorderly Kids*, Applicant has had success getting various retailers to stop using the mark based on their earlier use.

Accordingly, for at least the above-noted reasons, Applicant respectfully submits that the mark is not merely a decorative or ornamental feature of the goods but instead properly functions as a trademark by signifying the source of the goods sold or offered for sale. Thus, like in *Disorderly Kids*, “[t]his is not a case in which widespread ornamental use of the phrase by third parties ‘is part of the environment in which the [mark] is perceived by the public and ... may influence how the [mark] is perceived.’”

B. COMMONPLACE TERM, MESSAGE OR EXPRESSION

As noted in the outstanding Office Action, “[w]hether a designation functions as a mark depends on the commercial impression it makes on the relevant public; that is, whether purchasers would likely regard it as a source-indicator for the goods.” See *in re Keep A Breast Found.*, 123 USPQ2d 1869, 1879 (TTAB 2017)(quoting *In re Eagle Crest Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010)); TMEP §1202. Accordingly, for at least the reasons stated above, it is respectfully submitted that the mark is NOT a commonplace term, message or expression, regardless of the variety of sources identified in the outstanding Office Action, as purchasers regard the mark as a source-indicator for the goods. To further corroborate this notion and as shown in Exhibit 4, Applicant notes that it has used and branded the mark at least as early as August 29, 2018.



WeRateDogs®

@dog_rates

We made a new design for the first time in like a year.
We hope you like it

"tell your dog i said hi"

Available Now: weratedogs.com/collections/te...



12:00 PM · Aug 29, 2018 · Twitter for iPhone

2.1K Retweets and comments 17.9K Likes

As illustrated above, the tweet highlights the use of the mark in commerce and has received significant attention from followers garnering approximately 18,000 likes and 2100 retweets. Not only does this further demonstrate the source-indicating function of the mark but it pre-dates all of the evidence provided in the outstanding Office Action. Accordingly, it is respectfully submitted that the Office Action provides evidence not as to the mark being a commonplace expression but rather to the rampant use and replication of Applicant's mark. Thus, for at least the above-noted reasons, Applicant

respectfully submits that the mark is not a widely used message. See MPEP 1202.04(B).

II. CONCLUSION

Consequently, Applicant submits that the mark is acceptable for registration and requests reconsideration and favorable action in accordance herewith. If in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

/Jonathan W. Parthum/

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